

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/050,249	03/30/98	OKAMURA	H OKAMURA=2B

001444 HM12/1205
BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON DC 20001-5303

EXAMINER

JIANG, D

ART UNIT PAPER NUMBER

1646 18

DATE MAILED: 12/06/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/050,249

Applicant(s)

OKAMURA ET AL.

Examiner

Dong Jiang

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 93-117 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 97 is/are allowed.
- 6) ☒ Claim(s) 93-96 and 98-117 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/502535.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

The request filed on September 25, 2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08502535 is acceptable and a CPA has been established. An action on the CPA follows.

Insofar as the rejections of record are maintained below, applicant's arguments in the amendment filed on September 25, 2000 have been fully considered, but they are not persuasive. The newly amended claims failed to make substantial changes upon the issues addressed in the Final office action, paper number 13, filed on May 25, 2000. Therefore, certain rejections from the last Final office action still apply.

Additionally, applicant is reminded again that as allowable subject matter has been indicated (claims 81-84 from the previous amendment filed on June 18, 1999) in the last office action, applicant's response must either comply with all formal requirements or specifically traverse each requirement not complied with. In particular, **formal drawings are required in response to this Office action.** See 37 C.F.R. 1.111(b) and 707.07(a) of the M.P.E.P.

Rejections under 35 U.S.C. 112:

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 93-96 and 98-117 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the invention as now claimed. This rejection concerns the sufficiency of the written description with respect to the subject matter claimed. See the Commissioner's Revised Interim Guidelines published 21 December 1999 at 64 F.R. 71427-71440. This rejection is applied to the newly submitted claims for reasons of record as applied to claims 59-80, 89, 90 and 92 in paper number 13 at pages 3-4.

As stated in section 5. of the Final office action, paper number 13, filed on May 25, 2000, the question of possession of the claimed antibodies and methods employing them turns on a

Art Unit: 1646

determination as to possession of the IGIF proteins for which the antibodies are specific. The amended claims no longer require that the IGIFs be both of murine origin and closely related in structure to the exemplified murine IGIF having the sequence of SEQ ID NO: 2. They are thus generic to IGIF proteins meeting the broad functional limitation of independent claim 93 and various structural or biochemical limitations recited in various combinations in the dependent claims. To the extent that the claims read on antibodies which can react with any variants, which may be structurally and functionally related IGIF homologs, but may not be mIGIF, there is no written description of those variants in the disclosure as filed to support possession of the corresponding antibodies for reasons previously of record.

Applicants have not traversed this ground of rejection.

Conclusion:

Claim 97 is allowable.

Advisory Information:

This is a Continued Prosecution Application of applicant's earlier Application No. 09050249. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

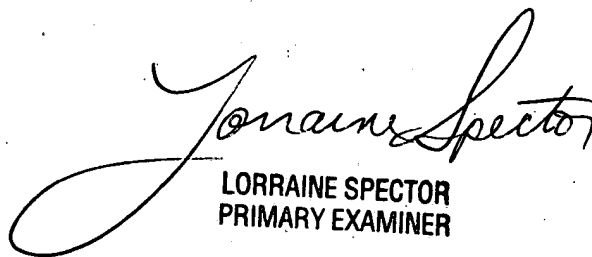
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 1646

Any inquiry concerning this communication should be directed to Dong Jiang whose telephone number is 703-305-1345. The examiner can normally be reached on Monday - Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564. The fax phone number for the organization where this application or proceeding is assigned is 703-308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


LORRAINE SPECTOR
PRIMARY EXAMINER

DJ
050249
12/4/00